

11. (Amended) The method according to claim 10, comprising the further steps of:  
removing said first core of said TUR and said print medium wound on said  
first core;  
placing said first core of said TUR and said wound print medium onto a  
spindle of said large format printer, such that an unprinted side of said rolled print medium is  
positioned to be printed upon by said large format printer; and  
sending another plot stream to said large format printer.

12. (Amended) The method according to claim 11, wherein said plot stream  
sending step comprises the step of electronically switching the order of said another plot  
stream.

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REMARKS

Claims 11 and 12 were amended to comply with matters of form and claims 1 and 10 were amended to more clearly define the subject matter of the invention and thereby place all of the claims remaining in the application in condition for allowance. Thus, claims 1-20 remain pending in the present application. Attached hereto is a marked up version of the changes made to the claims by the present amendment. The attached page is captioned "Version With Markings to Show Changes Made." No new matter was presented and such amendments are deemed unobjectionable. Entry thereof is respectfully requested. It is also respectfully requested that the Examiner reconsider the present application and claims as currently pending in view of the following remarks.

**I. Claim Objections**

In the Office Action, claim 12 was objected to as being vague and indefinite because of an informality. While Applicants are of the opinion that claim 12 is in fact clear and definite, Applicants have amended claims 11 and 12 to further clarify the claimed invention as suggested. Applicants assert that no new matter has been added, that the claims particularly point out and distinctly claim the subject matter that Applicants regard as the invention, and that the objected to claim is allowable. Accordingly, reconsideration and withdrawal of the objection to claim 12 is respectfully requested.

**II. Claim Rejections Under 35 U.S.C. § 102**

Claims 1, 2, and 10 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by U.S. Patent 6,443,555 to Silverbrook et al. (“Silverbrook”). Applicants respectfully assert that the rejection of claims 1, 2, and 10 is now moot in view of the amendments to claims 1 and 10. Thus, claims 1 and 10 are now allowable by virtue of the amendments thereto. Similarly, claim 2 is also now allowable by virtue of its dependency from now allowable claim 1.

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

With respect to the rejection of independent claims 1 and 10, the Silverbrook reference fails to disclose each and every element as arranged therein. Applicants' amended independent claims 1 and 10 recite, *inter alia*, loading a rolled print medium into a large format printer, and attaching a front edge of the rolled print medium to a core of a take up roll, such that a surface to be printed upon of the rolled print medium faces the core of the take up roll.

The Silverbrook reference appears to disclose a pagewidth wide format printer having a feed spool (40) and media (41) fed from the feed spool through a printhead assembly to a take up spool (42). Furthermore, drawing Figures 12 and 26 reveal that the media is wound to the take up spool such that an unprinted surface of the media faces the core of the take up spool. Figures 12 and 26 further reveal that the media is wound to the take up spool such that a surface to be printed upon faces opposite of the take up spool.

Nowhere in the Silverbrook reference is there any disclosure regarding attaching a front edge of rolled print medium so that a surface to be printed upon of the rolled print medium faces the core of the take up roll. Rather, Silverbrook discloses exactly the opposite. Thus, the Silverbrook reference fails to disclose Applicants' invention as claimed in amended claims 1 and 10. Therefore, independent claims 1 and 10 are distinguishable over the Silverbrook reference.

Based upon the above argument, Applicants respectfully submit that the Silverbrook reference does not disclose each and every element arranged as in claims 1 and 10 of Applicants' independent claims. Therefore, in applying the test for anticipation as set forth above in *Lindemann*, Silverbrook does not anticipate independent claim 1 or 10. Further, under principles of claim dependency and for at least the reasons stated above, Silverbrook does not anticipate dependent claim 2 either. Accordingly, reconsideration and withdrawal of the rejection of claims 1, 2, and 10 under 35 U.S.C. § 102 is respectfully requested.

### **III. Claim Rejections Under 35 U.S.C. § 103**

The Office Action rejected claims 3 and 16 under 35 U.S.C. § 103 as being unpatentable over Silverbrook in view of U.S. Patent Application 2001/0055041 to Yonekubo. Claims 4, 5, and 17 were rejected as being unpatentable over Silverbrook in view of U.S. Patent 6,406,126 to Clark. Claims 6, 7, and 18 were rejected over Silverbrook in view of Japanese Patent JP04345878 to Kaneko et al. (Kaneko). Claims 8 and 20 were rejected over Silverbrook in view of U.S. Patent 6,015,207 to Winter et al. (Winter) and Japanese Patent JP08292505 to Shinohara et al. (Shinohara). Claims 9 and 19 were rejected over Silverbrook in view of Japanese Patent JP05155106 to Suga. Claims 11 and 13-15 were rejected over Silverbrook in view of Japanese Patent JP09286128 to Ishida. Claim 12 was rejected over Silverbrook in view of Ishida and further in view of U.S. Patent 6,222,570 to Takayama et al. (Takayama). Applicants respectfully traverse each of the 35 U.S.C. § 103 rejections set forth herein for the reason that Applicants' invention is patentably distinguishable, and not an obvious improvement, over the cited references.

The Office Action has failed to set forth a *prima facie* case of obviousness. In order to establish a *prima facie* case of obviousness according to MPEP § 706.02(j), the cited references must teach or suggest all the claim limitations.

The cited reference(s) do not teach all of Applicants' claim limitations. There are fundamental differences between the claimed invention and the individual cited references and any combination thereof, such that all of the claim limitations of Applicants' invention are not met by Silverbrook, Yonekubo, Clark, Kaneko, Winter, Shinohara, Suga, Ishida, or Takayama, or any combination thereof.

Applicants' amended independent claims 1 and 10 recites, *inter alia*, loading a rolled print medium into a large format printer, and attaching a front edge of the rolled print medium to a core of a take up roll, such that a surface to be printed upon of the rolled print medium faces the core of the take up roll.

The Office Action generally alleges that the primary reference, Silverbrook, discloses the claimed invention as applied to independent claims 1 and 10 per the previously discussed § 102 rejection.

The Applicants respectfully disagree with the above allegations because there are significant structural and functional differences between Applicants' invention and Silverbrook, Yonekubo, Clark, Kaneko, Winter, Shinohara, Suga, Ishida, or Takayama, or any combination thereof. Contrary to the allegations in the Office Action, the primary reference, Silverbrook, fails to disclose, teach, or suggest attaching a front edge of a rolled print medium to a core of a take up roll, such that a surface to be printed upon of the rolled print medium faces the core of the take up roll. In contrast, Silverbrook teaches winding media to a take up spool such that an unprinted surface of the media faces the core of the take up spool and such that a surface to be printed upon faces opposite of the take up spool. Thus,

not only does Silverbrook not meet all of Applicants' claim limitations, the Silverbrook reference teaches the exact opposite of Applicants. As stated in the MPEP, if any of the cited references teach away from the suggested combination, or teach away from the claims, or render any of the cited references unsatisfactory for their intended purpose, the claimed invention is distinguishable over the combination of cited references. (MPEP § 2145) Finally, none of the secondary references (Yonekubo, Clark, Kaneko, Winter, Shinohara, Suga, Ishida, or Takayama) correct for the above-mentioned deficiency in Silverbrook, nor is such an allegation made in the Office Action.

Applicants' invention is thus an unobvious improvement over the cited references and not an obvious combination of any of the references of record in this application. When viewed singularly or collectively, none of the cited references discloses, teaches, or even suggests Applicants' claimed invention. Thus, independent claims 1 and 10 are not rendered obvious by any of the cited references. Under principles of claim dependency and for at least the reasons stated above, Silverbrook, Yonekubo, Clark, Kaneko, Winter, Shinohara, Suga, Ishida, and Takayama do not render obvious any of the dependent claims either. Therefore, reconsideration and withdrawal of the § 103 rejections are respectfully requested.

**IV. Conclusion**

In view of the foregoing remarks, the Applicants respectfully submit that the pending independent and dependent claims are in proper form, define patentably over the cited references, and are all allowable. Applicants, therefore, respectfully request that the Examiner's objections and rejections under 35 U.S.C. § 102 and 103 be reconsidered and withdrawn and that a formal Notice of Allowance of the application be issued.

If the Examiner has any questions with respect to any matter now of record, the Applicants' attorney may be reached at the telephone number below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

WILMER, CUTLER & PICKERING

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Version With Markings to Show Changes Made

Pursuant to 37 CFR § 1.121, the following is a copy of all amendments with deletions indicated by bracketing and additions indicated by underlining.

In the Claims

*Claims 1, 10, 11, and 12 have been amended as follows:*

1. (Amended) A method of removing roll-set curl in a print medium rolled on a core utilizing a large format printer equipped with a take up reel ("TUR"), said method comprising the steps of:
  - activating a TUR having a core;
  - loading said rolled print medium into said large format printer;
  - advancing said rolled print medium through said large format printer until a front edge of said rolled print medium is adjacent to said TUR;
  - attaching said front edge of said rolled print medium to said core of said TUR, such that a surface to be printed upon of said rolled print medium faces said core of said TUR; and
  - rotating said core of said TUR in a direction substantially opposite a direction of said rolled print medium on said core to substantially wind said rolled print medium on to said core of said TUR.

10. (Amended) A method of printing on both sides of a print medium rolled on a core utilizing a large format printer equipped with a take up reel ("TUR"), said method comprising the steps of:

activating a TUR having a first core;

loading said rolled print medium into said large format printer;  
sending a plot stream to said large format printer;  
printing said plot stream onto a first surface of said rolled print medium;  
advancing said rolled print medium through said large format printer until a  
front edge of said rolled print medium is adjacent to said TUR;

attaching said front edge of said rolled print medium to said first core of said  
TUR, such that a surface to be printed upon of said rolled print medium faces said first core  
of said TUR; and

rotating said first core of said TUR in a direction substantially opposite a  
direction of said print medium roll to substantially wind said rolled print medium on to said  
first core of said TUR.

11. (Amended) The method according to claim 10, comprising the further steps of:  
removing said first core of said TUR and said print medium wound on said  
first core;

placing said first core of said TUR and said wound print medium onto a  
spindle of said large format printer, such that an unprinted side of said rolled print medium is  
positioned to be printed upon by said large format printer; and  
sending [a] another plot stream to said large format printer.

12. (Amended) The method according to claim 11, wherein said plot stream  
sending step comprises the step of electronically switching the order of said another plot  
stream.